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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,084	03/31/2004	Stephen T. Flock	D6-462CIP2	7354
7590 Benjamin Aaron Adler ADLER & ASSOCIATES 8011 Candle Lane Houston, TX 77071				
10/22/2009				
EXAMINER				
ROANE, AARON F				
ART UNIT		PAPER NUMBER		
3769				
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10/22/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/815,084

Applicant(s)

FLOCK ET AL.

Examiner

Aaron Roane

Art Unit

3769

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11, 13 and 15-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11, 13 and 15-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Claim Objections***

Claim 21 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In the present claims the subject matter of claim has been incorporated into independent claim 1.

Additionally, it should be noted that claims 22-24, all dependent directly/indirectly from claim 21 which depends directly on claim 1.

***Double Patenting***

Claim 21 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 13 and 15-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon (U.S. Patent 4,889,120) in view of Sawyer (U.S. Patent 5,824,015) in further view of Hedge et al. (U.S. Patent 6,656,174).

Regarding claims 1-5, 21 and 22, Gordon discloses a method of treatment for one or more tissue substrates in an individual, comprising: securing the tissue substrates proximal to a ferromagnetic metal susceptor; applying radiofrequency energy that generates a magnetic field to said substrate(s) or to said susceptor or to a combination thereof to inductively generate heat therein; and affixing said substrates together via said heat thereby effecting treatment, see abstract, col. 2:28 - col. 3:62. Gordon fails to explicitly recite controlling the affixing of said substrates via feedback monitoring of a property of said susceptor, said energy or a combination thereof, wherein said property is heat, an electrical property, eddy currents, conductivity, or frequency changes or a combination thereof. It is well known in the art that the connection of different portion of biological tissue can be effected by the crosslinking of collagen, wherein two portions of biological tissue are placed in abutment with each other and heated by various means: laser, RF, microwave, resistive heating, etc. (well known in the art) in order to achieve the crosslinking. It is important that the heating (i.e. temperature obtained by tissue) be high enough to achieve the crosslinking but not so high as to damage and/or ablate the tissue. Sawyer discloses a method for welding biological tissue and teaches that it is well

known in the art to denature of collagen containing substances and/or tissues (interpreted as including crosslinking collagen) by heating the substances and/or tissues to a temperature of 45° C to 75° C in order to form tissue welds/seals, see col. 2:27 – col. 3:25 in general and col. 3:46–65 in particular. Hedge et al. disclose and device and method for heat treating biological tissue with RF energy and teach “the interior electrodes 48 and temperature sensing elements 26 are electrically coupled to the respective RF generator 18 and controller 19, allowing RF power to be delivered to the inflatable chambers 36, and thus, the targeted tissue, under temperature-feedback control,” see col. 8:65 – col. 9:2 and figures 1 and 5. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Gordon, as taught by Sawyer, to provide a particular heating temperature range for the treated tissue site in order to achieve a collagen crosslinked tissue seal/weld, and as further taught by Hedge et al., to provide the system with temperature sensors and temperature-feedback control in order to obtain and maintain a particular tissue treatment site temperature (tissue/substrate heat). Regarding claims 6 and 7, Gordon discloses the substrates may be further secured by a surgical fastener in the form of 2 to 3 sutures, see col. 6:29-31.

Regarding claims 8 and 9, Gordon discloses the claimed invention, see col. 3:8-25 and col. 6:43-48 and claims 1-4, particularly claim 4.

Regarding claims 13, 15-18, Gordon discloses the claimed invention, see col. 5:48-65.

Regarding claims 19 and 20, Gordon discloses the claimed invention, see col. 2:1-18 and col. 2:44-53.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon (U.S. Patent 4,889,120) in view of Sawyer (U.S. Patent 5,824,015) in further view of Hedge et al. (U.S. Patent 6,656,174) as applied to claim 1 above, and in view of Aida et al. (U.S. Patent 5,897,495).

Regarding claim 11, Gordon in view of Sawyer and further in view of Hedge et al. disclose the claimed invention except for explicitly reciting the radio frequency energy is applied in pulses. It is well known in the art that radio frequency may be applied in a continuous duration or in discrete pulses. Aida et al. disclose a system and method of heat-treating tissue and teach "a transmitter coil for transmitting radio frequency pulses to the treatment target portion such that the thermal treatment can be applied to the treatment target portion by the heat induced by the radio frequency pulses," see col. 12:56-60 and figure 9. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Gordon in view of Sawyer and further in view of Hedge et al. disclose, as taught by Aida et al., to provide radio frequency energy in pulses in order to heat-treat tissue.

Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon (U.S. Patent 4,889,120) in view of Sawyer (U.S. Patent 5,824,015) and in further view of Hedge et

al. (U.S. Patent 6,656,174) as applied to claim 22 above, and still in further in view of Eggers et al. (U.S. Patent 5,366,443).

Regarding claims 23 and 24, Gordon in view of Sawyer in further view of Hedge et al. disclose the claimed invention except for heat is monitored via infrared optical detection. It is extremely well known in the art to provide temperature sensors in various alternate/equivalent means such thermistors and infrared optical sensors for example. Eggers et al. disclose a medical device and method and teach “the temperature sensing may be achieved using fiber optics with infrared sensing technique, a thermocouple, a thermistor or other temperature sensing means,” see col. 11:34-42. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Gordon in view of Sawyer in further view of Hedge et al., as taught by Eggers et al., to provide the device and system with fiber optics with infrared sensing technique (optical infrared sensing) in order to provide specific example of temperature sensing means.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-9, 11, 13 and 15-20 have been considered but are moot in view of the new ground(s) of rejection. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. The new grounds of rejection is based on the combination of Gordon (U.S. Patent 4,889,120) in view of Sawyer (U.S. Patent

5,824,015) in further view of Hedge et al. (U.S. Patent 6,656,174) which was used in the previous office action for rejecting claims 21 and 22. This follows since claim 1 was amended to incorporate the subject matter of claim 21. So the only response required by the examiner is a rebuttal of Applicant's arguments/remarks traversing the combination of Gordon in view of Sawyer in further view of Hedge et al.

On page 8 of 14, 2<sup>nd</sup> full paragraph through page 10 of 14, 2<sup>nd</sup> full paragraph, Applicant attacks the combination of Gordon in view of Sawyer in further view of Hedge et al. for rejecting claims 21 and 22. Again It should be noted this argument/remark also apply to claim 1, as claim 1 was amended to incorporate the subject matter of claim 21. Applicant's argument/remark is two pronged: 1) summarizing and then attacking each reference individually and 2) stating "the references must provide a reasonable expectation of success and a motivation to combine the teachings."

Firstly, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Secondly, the examiner believes Applicant is challenging the success of the combination is because Applicant is using bodily incorporation which is a flaw in argumentation. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of

the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Thirdly, and similarly to the second point made immediately above, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In *re Keller*, 642 F. 2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In this regard, a conclusion of obviousness may be based on common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. In *re Bozek*, 416 F .2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

**The Applicant is invited to request an interview to discuss suggestions to find an acceptable conclusion of the prosecution for all parties.**

**The rejections are maintained and this action is made FINAL.**

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Roane whose telephone number is (571) 272-4771. The examiner can normally be reached on Monday-Thursday 8:30AM-7PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Johnson can be reached on (571) 272-4768. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aaron Roane/  
Examiner, Art Unit 3769

/Ahmed M Farah/  
Primary Examiner, Art Unit 3769